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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85849487
Applicant	PumpTek Asia Limited dba PumpTek
Applied for Mark	RECON
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:

Name: PumpTek Asia Limited DBA PumpTek

Law Office: 105

Serial No.: 85/849,487

Filed: February 14, 2013

Trademark Attorney:
Maureen Dall Lott

Trademark: RECON

Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

BRIEF FOR APPLICANT-APPELLANT

A. INTRODUCTION

Pursuant to a Notice of Appeal filed with the Trademark Trial and Appeal Board on July 7, 2014, the Applicant-Appellant (hereafter, the Applicant”) hereby appeals from the Examining Attorney's final refusal to register the above-identified mark, dated November 13, 2015, and respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision on the grounds that the Applicant's mark does not create a likelihood of confusion with the mark cited by the Examining Attorney.

B. STATEMENT OF FACTS

Applicant seeks registration on the Principal Register of its mark, RECON, for “oil and gas well downhole survey and measurement equipment, namely, downhole sensors for use in monitoring well performance and conditions”, in International Class 09. The trademark application was filed on February 14, 2013, and received U.S. Trademark Application Serial No. 85/849,487.

The Examining Attorney refused registration of Applicant's mark RECON in an Office Action, dated June 6, 2013, contending that the mark, when used on or in connection with the recited goods, is likely to be confused with: 1) U.S. Registration No. 2,965,297, for the mark RECON for “impact, temperature, and vibration resistant, water-impervious, handheld computers for use in geographical information systems field work, agricultural and construction work, land surveying, public safety, field service, utilities, military and other outdoor or service-related applications.”; 2) U.S. Registration No. 4,347,462, for the mark RECONHD for “Scientific imaging services in the nature of computed tomography images or scanning electron microscope images of subsurface drill cuttings from geologic formations, such services performed in a laboratory or at a drill site; scientific imaging in the nature of generating computed tomography images or scanning electron microscope images of drill cuttings,” and 3) U.S. Registration No. 3,470,400, for the mark RECON for “3-D geological interpretation software, namely, software used on PC workstations by specific sectors of the oil and gas exploration and production industry to interpret geological measurements, namely, seismic and oil and gas well log data in an interactive, 3-D visualization environment, enabling the user to display polygonal representations of oil and gas well logs in combination with graphics texture representations of sub-surface seismic data, for the purpose of manually interpreting and defining a three-dimensional model of the subsurface geological layers.”

In the Applicant's response to the initial refusal to register, filed on December 6, 2013, the Applicant argued that the cited mark RECONHD is not similar in sound, appearance or overall commercial impression to the Applicant's mark, and that the goods of all the cited marks were not related to Applicant's goods, so that there would not be a likelihood of confusion between the cited marks and the Applicant's mark.

The Examining Attorney further expounded her position in a Final Office Action, dated January 7, 2014, maintaining that the Applicant's mark and Registrants' marks are similar, and that the Applicant's goods and the Registrants' goods are related. The Examining Attorney supported her refusal by citing Internet evidence that she alleged established that many entities provide a variety of goods and services that may be used in the downhole drilling, survey and measurement field, and therefore they are often provided in the same trade channels.

In response thereto, the Applicant requested reconsideration of the Examining Attorney's final refusal on July 7, 2014, by citing the coexistence of many registered marks that include the word element “recon” as evidence of the weakness of the mark RECON for the cited goods. The Applicant also cited case law that in a crowded field of similar marks, each member of the crowd is relatively weak and entitled to a very narrow scope of protection.

On August 7, 2014, the Examining Attorney issued a Suspension Notice due to the filing of registration maintenance documents for the cited mark under U.S. Registration No. 3,470,400, for the mark RECON, which she stated was not yet been accepted by the Office. Then, on April 21, 2015, upon further review, the Examining Attorney issued a new Office Action, withdrawing all previous refusals to register the Applicant's mark RECON, however issued a new refusal contending that the Applicant's mark, when used on or in connection with the recited goods, is likely to be confused with the newly cited U.S. Registration No. 4,390,138, for the mark RECON (& DESIGN) as it appears below:



for “battery chargers; chargers for electric batteries; circuit breakers; electric apparatus for commutation; commutators; electric control panels; electric converters; current rectifiers; electrical distribution boards; electrical distribution boxes; electric installations for the remote control of industrial operations; high-frequency apparatus not for medical purposes, namely, power converters for renewable energy; inverters; electric regulating apparatus, namely, static voltage regulators and digital regulators for power converter; electric relays; remote control apparatus, namely, remote control for electrical automation and energy converters; surveying apparatus and instruments not for medical purposes; electric switchboxes; electrical switches; electric transformers; voltage surge protectors; none of the aforementioned goods for use in connection with internal combustion engines or internal combustion engine parts and components.”

In particular, the Examining Attorney cites the following of Registrant's goods at issue in the new refusal: *“surveying apparatus and instruments not for medical purposes; none of the aforementioned goods for use in connection with internal combustion engines or internal combustion engine parts and components.”*

In response to the newly raised refusal in the Office Action dated April 21, 2015, Applicant filed Applicant's response on October 21, 2015, and submitted evidence regarding the definition of the term “surveying”, and argued the distinction between of the Applicant's goods and the Registrant's goods.

Finally, the Examining Attorney maintained and made final her refusal to register the Applicant's mark on November 13, 2015, finding for a broader definition of the term “surveying”. The Examining Attorney also supported her finding that Registrant's goods appear to encompass Applicant's goods by referencing Internet evidence allegedly establishing that many entities provide a variety of surveying/measuring goods, especially in the drilling field there the goods are related.

C. ARGUMENTS

- I. APPLICANT'S GOODS ARE UNRELATED TO REGISTRANT'S GOODS SINCE THERE IS NO "PER SE" RULE THAT ALL SURVEYING APPARATUS AND INSTRUMENTS (NOT FOR MEDICAL PURPOSES AND NOT USED IN CONNECTION WITH INTERNAL COMBUSTION ENGINES OR INTERNAL COMBUSTION ENGINE PARTS AND COMPONENTS) AND DOWNHOLE SENSORS (FOR USE IN MONITORING WELL PERFORMANCE AND CONDITIONS) ARE RELATED.

The Examining Attorney must determine whether there is a likelihood of confusion on the basis of the goods identified in the application and registration. [In re Elbaum, 211 U.S.P.Q. \(BNA\) 639, 1981 WL 40489 \(Trademark Trial & App. Bd. 1981\)](#). The goods at issue of this appeal, which are identified in U.S. Registration No. 4,390,138, are for "surveying apparatus and instruments not for medical purposes; none of the aforementioned goods for use in connection with internal combustion engines or internal combustion engine parts and components."

Following the Examining Attorney's logic, this registration is not just for "surveying apparatus and instruments," but encompasses an overly broad interpretation of the term "surveying", meaning any and all types of apparatus and instruments that "examine the particulars of something". This is based on the Examining Attorney's reference to the definition of the term "survey" from the "Infoplease" website at the domain name <http://dictionary.infoplease.com/survey>, which was submitted with the Office Action dated November 13, 2015.

The Trademark Office requires that an applicant specifically list the identification of goods in its application. The rationale for specifically listing the type of equipment or instruments and not merely filing by international class is to differentiate between the types of equipment or instruments that the mark is used in connection with in the market place. This is done so that the likelihood of confusion determination is not pro forma or routine, but judged based upon the realities of how products are sold or marketed. In other words, the Examining Attorney cannot create imaginary scenarios whereby she rationalizes finding confusion between two "unrelated" types of instruments or equipment, merely because in some imaginary marketplace, these particular goods could conceivably be sold through the same channels of trade to the same classes of purchasers. The Examining Attorney does not seem sure as to relatedness of the goods based on her use of following statement in the Office Action dated November 13, 2015, stating that "...Registrant's goods *appear* to encompass Applicant's goods..." based on the referenced, cursory Internet evidence allegedly establishing that many entities provide a variety of surveying/measuring goods, especially in the drilling field, therefore the goods are related.

The Applicant respectfully states that the Applicant's goods are specific downhole sensors that are used in the oil and gas industry to *monitor* the conditions inside an oil or gas well. The Registrant's goods are survey apparatus and instruments, which have to be understood based on the common definition of the word "survey" meaning "*determining the distances of objects for the purposes of establishing maps.*" This argument was referenced in the Applicant's Response to the Office Action submitted on October 21, 2015, along with the referenced definitions.

The intended uses and the intended purchasers of the Applicant's goods and the Registrant's goods are different in terms of how the goods are marketing as well as the channels of trade the goods travel; the goods are unrelated. Therefore, it is Applicant's position that the Applicant's mark is registrable on the Office's Principal Register.

II. APPLICANT'S AND REGISTRANT'S MARKS ARE WEAK AND ENTITLED TO A NARROW SCOPE OF PROTECTION.

In light of a review of the entire prosecution history of the applied-for mark, the Applicant references copies of other U.S. Trademark Registrations that were cited against the Applicant's mark; there registrations were attached to prior Office Actions issued against the subject application. [*See the Attachments to the Office Action dated June 6, 2013 and Applicant's Request for Reconsideration dated July 7, 2014*].

These include marks, which include the word element "recon" for use in connection with various technical products that could be construed to encompass the Examining Attorney's overly broad definition of the term "survey"; meaning to "examine the particulars of something".

Please note that the Examining Attorney *withdrew her refusals* to register the Applicant's mark in regards of those cited registrations in the Office Action dated April 21, 2015. They include the following marks:

<u>Mark / Reg. No.</u>	<u>Owner</u>	<u>Goods / Services</u>
RECON Reg. No.: 2,965,297	TRIMBLE NAVIGATION LIMITED	Impact, temperature, and vibration resistant, water-impervious, handheld computers for use in geographical information systems field work, agricultural and construction work, land surveying, public safety, field service, utilities, military and other outdoor or service-related applications.
RECON Reg. No.: 3,470,400	Austin Geomodeling, Inc.	3-D geological interpretation software, namely, software used on PC workstations by specific sectors of the oil and gas exploration and production industry to interpret geological measurements, namely, seismic and oil and gas well log data in an interactive, 3-D visualization environment, enabling the user to display polygonal representations of oil and gas well logs in combination with graphics texture representations of sub-surface seismic

data, for the purpose of manually interpreting and defining a three-dimensional model of the subsurface geological layers.

RECONHD
Reg. No.: 4,347,462

Ingrain, Inc.

Scientific imaging services in the nature of computed tomography images or scanning electron microscope images of subsurface drill cuttings from geologic formations, such services performed in a laboratory or at a drill site; scientific imaging in the nature of generating computed tomography images or scanning electron microscope images of drill cuttings.

Such third party use demonstrates two important points: (1) that the word element RECON is a weak mark entitled to a limited scope of protection vis-à-vis other marks which use the term RECON for other technical products that “examine the particulars of something”; and (2) that these registrations are able to co-exist on the Principal Register without causing a likelihood of confusion with each other.

Accordingly, Applicant maintains that use and registration of its mark RECON, for "oil and gas well downhole survey and measurement equipment, namely, downhole sensors for use in monitoring well performance and conditions" is not likely to lead to confusion, mistake or deception with U.S. Registration No. 4,390,138, for the mark RECON (& DESIGN) for its listed goods for "surveying apparatus and instruments not for medical purposes; none of the aforementioned goods for use in connection with internal combustion engines or internal combustion engine parts and components."

Such numerous third party use of marks which contain the word element "recon" in connection with other technical goods clearly demonstrates that RECON is an extremely weak mark in that context and that the cited registration for RECON (& DESIGN) is entitled to a narrow scope of protection vis-à-vis other RECON marks. TMEP Rule 1207.01(c)(iv) (third party registrations can be used to show that a mark is suggestive or descriptive of certain goods and hence entitled to a narrow scope of protection).

The Applicant submits as further evidence of the unrelatedness of the Applicant's and Registrant's goods, the fact that the above-referenced registrations have coexisted simultaneously with the cited RECON (& DESIGN) registration on the Principal Register without creating a likelihood of confusion.

To summarize, the unrelatedness of the goods combined with the fact that several third party RECON marks for various technical goods have coexisted simultaneously on the Principal

Register without creating a likelihood of confusion, supports the conclusion that purchasers of one party's goods are not likely to mistakenly assume that such goods originate from, are sponsored by, or are in some way associated with the other party. Accordingly, there is no likelihood of confusion between the Applicant's RECON mark and the cited RECON (& DESIGN) mark.

D. CONCLUSION

For the reasons set forth hereinabove, Applicant submits that there is no likelihood of confusion, mistake or deception between Applicant's mark and the cited registration under U.S. Registration No. 4,390,138. Accordingly, Applicant's mark is entitled to registration.

The Board is therefore respectfully requested to reverse the Examiner's decision refusing registration of Applicant's mark.

Respectfully submitted,

October 14, 2016
Dated: _____

/Sunisha S. Choksi/
By: _____

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